

Application No.: 09/963,551

REMARKS

Claims 2 and 8 are independent and stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Anderson '137 ("Anderson") in view of Finelli '676 ("Finelli"). This rejection is respectfully traversed for the following reasons.

The Examiner admits that Anderson does not disclose or suggest the image being transferred from the image memory to the storage medium while the image is presented by the display. The Examiner therefore relies on col. 6 of Finelli as allegedly disclosing this feature and thereby modifies Anderson in an attempt to reach the claimed invention. However, it is respectfully submitted that Finelli is completely silent as to the aforementioned feature.

Finelli merely discloses a conventional camera in which an image is *first* stored in the storage device 80 and *thereafter* can be recalled by the user for display on the LCD 62. That is, Finelli does not disclose sending the image signal to the storage device 80 while the image signal, in the process of being stored, is also sent to the LCD 62 for display. In direct contrast, Finelli states that "the compressed electronic image information signals [are] provided from the electronic imaging camera 12 ... for storage in the storage device 80 [or] *alternatively*, and at the camera user's discretion by way of appropriately actuated switches" (col. 6, lines 2-14), the image signals are uncompressed and "*thereafter* directed to an image enhancement circuit 116" (col. 6, lines 15-19) to prepare the image for display on the LCD 62. In other words, the images *already stored* in the storage device 80 are *recalled* from the storage device 80 (col. 6, line 37) for display on LCD 62. Indeed, in describing the separate operation modes for the camera, Finelli expressly discloses (col. 7, lines 3-8):

the camera user can direct the electronic information signals for each scene *for storage in the storage device 80*. The electronic image information signals can then be recalled for display on the LCD 62 to determine what images are to be transformed into hard copy.

Application No.: 09/963,551

Accordingly, as expressly described by Finelli, the image signals are first stored in the storage device 80 after which the image signals can be recalled *from* the storage device 80 and then displayed on the LCD 62. Finelli does not suggest a device which can enable having image signals displayed while being stored *into* the storage device 80.

The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for establishing obviousness under § 103:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claims 2 and 8 because the proposed combination fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 2 and 8 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 103 be withdrawn.

Application No.: 09/963,551


CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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